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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 913,373	01/28/2002	Gregory N. Beach	480102.408USPC	9543

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EXAMINER

WRIGHT, SONYA N

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,373

Applicant(s)

BEATCH ET AL.

Examiner

Sonya Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-85 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-85 are pending in this application.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Due to the numerous variables in the claims, e.g. A, X, Q, R1, R2, R3, R4, R5, R6, R7, R8, R9, R13, etc. . . and their widely divergent meanings, a precise listing of inventive groups can not be made. The following groups are exemplary:

Group I claims 1-85, drawn to compounds in formula (I) wherein n is 1; Q is O (oxygen) X is a direct bond, Y is a direct bond, R1 and R2 are independently selected from hydrogen, C1-C8alkyl, C3-C8alkoxyalkyl, C1-C8 hydroxyalkyl, and C7-C12aralkyl; R3 and R4 are independently attached to the cycloalkyl ring shown in formula (I) at other than the 1 and 2 positions and are independently selected from hydrogen, hydroxy, C1-C6alkyl, and C1-C6alkoxy and when R3 and R4 are attached to the same cycloalkane ring atom, they do not together form a spiro five- or six-membered heterocyclic ring containing one or two heteroatoms selected from oxygen and sulfur; R5, R6, and R14 are independently selected from hydrogen, C1-C6alkyl, aryl and benzyl; and A is selected from C5-C13carbocyclic ring; classified in various classes and subclasses.

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Group II claims 1-85 drawn to compounds in formula (I) wherein n is 1; Q is O (oxygen) X is a direct bond, Y is a direct bond, R1 and R2 are taken together with the nitrogen atom to which they are directly attached in formula (I) to form a bicyclic ring system selected from 3-azabicyclo[3.2.2]nonan-3-yl or 2-azabicyclo[2.2.2]octan-2-yl; R3 and R4 are independently attached to the cycloalkyl ring shown in formula (I) at other than the 1 and 2 positions and are independently selected from hydrogen, hydroxy, C1-C6alkyl, and C1-C6alkoxy and when R3 and R4 are attached to the same cycloalkane ring atom, they do not together form a spiro five- or six-membered heterocyclic ring containing one or two heteroatoms selected from oxygen and sulfur; R5, R6, and R14 are independently selected from hydrogen, C1-C6alkyl, aryl and benzyl; A is selected from ring system (III); and R7 R8 and R9 are independently bromine, chlorine, or fluorine; classified in various classes and subclasses.

Group III claims 1-85 drawn to compounds in formula (I) n is 1; Q is O (oxygen) X is a direct bond, Y is a direct bond, R1 and R2 are independently selected from hydrogen, C1-C8alkyl, C3-C8alkoxyalkyl, C1-C8 hydroxyalkyl, and C7-C12aralkyl; R3 and R4 are attached to the same cycloalkane ring atom, and they together form a spiro five- or six-membered heterocyclic ring containing one or two heteroatoms selected from oxygen and sulfur; R5, R6, and R14 are independently selected from hydrogen, C1-C6alkyl, aryl and benzyl; and A is selected from C5-C13carbocyclic ring; classified in various classes and subclasses.

Group IV claims 1-85 drawn to compounds of formula (I) n is 1; Q is O (oxygen) X is a direct bond, Y is a direct bond, R1 and R2 are independently selected from

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hydrogen, C1-C8alkyl, C3-C8alkoxyalkyl, C1-C8 hydroxyalkyl, and C7-C12aralkyl; R3 and R4 are independently attached to the cycloalkyl ring shown in formula (I) at other than the 1 and 2 positions and are independently selected from hydrogen, hydroxy, C1-C6alkyl, and C1-C6alkoxy and when R3 and R4 are attached to the same cycloalkane ring atom, they do not together form a spiro five- or six-membered heterocyclic ring containing one or two heteroatoms selected from oxygen and sulfur; R5, R6, and R14 are independently selected from hydrogen, C1-C6alkyl, aryl and benzyl; A is selected from ring system (VI); R12 is bromine, chlorine, or fluorine; and Z is N; classified in various classes and subclasses.

Again, this list is not exhaustive. It would be impossible to formulate a complete list under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, Applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same.

With the election of a specific exemplified compound, a generic compound will be identified by the examiner as the inventive group for examination.

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain a cycloalkyl group with substituents A, X, Q, R1, R2, R3, R4, R5, R6, R7, R8, R9, R13, etc. . . which does not define a contribution over the prior art. The substituents on the cycloalkyl group vary extensively and when taken as a whole result

in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Moreover to not restrict herein, would impose a burden on the examination of this application.

A telephone call was made to Mr. Parker on 8-14-02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright, whose telephone number is (703) 308-4539. The examiner can normally be reached on Monday-Friday from 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

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When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.



Joseph K. McKane

Supervisory Patent Examiner

Group 1600

Sonya Wright

February 10, 2003